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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,724	03/19/2001	Masahiro Inoue	01145/LH	9510
1933	7590	09/13/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			BOUTAH, ALINA A	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/811,724	INOUE ET AL.
	Examiner Alina N Boutah	Art Unit 2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 19 March 2001.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,7-11 and 15 is/are rejected.
- 7) Claim(s) 4-6 and 12-14 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 March 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892) ✓
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 4/7/2004.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,334,109 issued to Kanevsky et al. (hereinafter referred to as Kanevsky) in view of USPN 6,351,745 issued to Itakura et al. (hereinafter referred to as Itakura).

Regarding claim 1, Kanevsky teaches an advertisement distribution system which receives advertisement contents from at least one advertisement provider through a

communications network, and provides at least one advertisement user with the received advertisement contents through the communications network, said system comprising:

an advertisement information storage unit which stores advertisement contents received from the at least one advertisement provider in association with advertisement provider information for controlling providing of an advertisement and corresponding to the received advertisement contents (abstract; figure 1; col. 1, line 59 to col. 2, line 7);

an advertisement-user information storage unit which stores advertisement usage information, for specifying a desired advertisement, of the at least one advertisement user (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

an advertisement extraction unit which extracts advertisement contents corresponding to advertisement provider information in association with the stored advertisement usage information (figure 3, 209; col. 2, lines 44-57); and

a transmission unit which transmits the advertisement contents extracted by said advertisement extraction unit to the at least one advertisement user having requested the advertisement contents (col. 4, lines 30-33).

Regarding claim 2, Kanevsky teaches the advertisement distribution system according to claim 1, wherein:

the advertisement provider information includes an advertisement providing condition which is to be specified by the at least one advertisement provider for predetermined advertisement contents (figure 5, 302; col. 1, lines 20-34);

the advertisement user information includes an advertisement-specification condition which is to be specified by the at least one advertisement user (figure 5, 302; col. 9, lines 25-44); and

the advertisement extraction unit searches an advertisement providing condition conforming to the input advertisement-specification condition, and retrieves advertisement contents corresponding to the advertisement provider information including the searched advertisement providing condition (col. 6, lines 8-28).

Regarding claim 3, Kanevsky fails to explicitly teach the advertisement distribution system according to claim 2, wherein said advertisement extraction unit includes an advertisement selection unit which selects, when more than a predetermined number of items of advertisement provider information including the searched advertisement providing condition are retrieved, a predetermined number of items of advertisement provider information included in the retrieved items of advertisement provider information. Itakura teaches a predetermined number of items of advertisement provider information included in the retrieved items of advertisement provider information (col. 5, lines 1-28). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Itakura with the teaching of Kanevsky in order to keep track the number of times the advertisement has

been transmitted to users, therefore always keeping users updated on products, therefore maximizing the system's efficiency.

Regarding claim 7, Kanevsky teaches a store terminal device which receives advertisement contents to be sent by an advertisement provider from an advertisement server connected to said store terminal device through a communications network, said device comprising:

an advertisement content storage unit which receives advertisement contents, which are selected and transmitted in accordance with store attribute information of a store having sent the store attribute information from said advertisement server, and advertisement attribute information corresponding to the advertisement contents (abstract; figure 1; col. 1, line 59 to col. 2, line 7);

an advertisement content specification unit which specifies at least one advertisement content included in the advertisement contents stored in said advertisement content storage unit, when to use an advertisement (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

an advertisement outputting unit which outputs the advertisement content specified by said advertisement content specification unit (col. 4, lines 30-33).

However, Kanevsky fails to explicitly teach the advertisement content storage unit receiving a predetermined number of advertisement contents, and sequentially storing the received advertisement contents and advertisement attribute information; an

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advertisement-usage-context management unit which updates and retains, every time the advertisement content output by said advertisement outputting unit, advertisement usage context corresponding to the output advertisement content; and a sending unit which sends the advertisement usage context retained by said advertisement-usage-context management unit to said advertisement server at predetermined intervals.

Itakura teaches the advertisement content storage unit receiving a predetermined number of advertisement contents (col. 5, lines 1-28);

sequentially storing the received advertisement contents and advertisement attribute information (figures 7-12);

an advertisement-usage-context management unit which updates and retains, every time the advertisement content output by said advertisement outputting unit, advertisement usage context corresponding to the output advertisement content (col. 5, lines 1-28); and

a sending unit which sends the advertisement usage context retained by said advertisement-usage-context management unit to said advertisement server at predetermined intervals (figure 30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Itakura with the teaching of Kanevsky in order to keep track the number of times the advertisement has been transmitted to users, storing the received advertisement in sequential order in order to provide quick access to the storage, updating and retaining the advertisement content in order to make

sure that each user receives advertisements, therefore maximizing the system's efficiency.

Regarding claim 8, Kanevsky fails to explicitly teach the store terminal device according to claim 7, wherein said advertisement specification unit specifies the advertisement content stored in said advertisement content storage unit sequentially in storage order. Itakura teaches the advertisement specification unit specifying the advertisement content stored in said advertisement content storage unit sequentially in storage order (figures 7-12). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to store the advertisement content unit sequentially in order to provide quick access to the storage when searching is being done, therefore maximizing the system's efficiency.

Regarding claim 9, Kanevsky teaches the store terminal device according to claim 7, wherein:

said advertisement attribute information includes an advertisement providing condition for an advertisement content corresponding to the advertisement attribute information (figure 3; col. 5, lines 33-43); and

said advertisement content specification unit specifies, when an advertisement specification condition is input by an advertisement user, an advertisement content

corresponding to the advertisement providing condition conforming to the input advertisement specification condition (col. 5, lines 33-43).

Regarding claim 10, Kanevsky teaches the store terminal device according to claim 7, further comprising:

a transaction registration processor which registers and calculates sales data for each business transaction, at each business transaction with a customer (abstract);

a receipt issuing unit which issues a receipt based on the calculation done by said transaction registration processor (abstract); and

a printing unit which prints the advertisement content output by said advertisement outputting unit together with the sales data on a receipt to be issued by said receipt issuing unit (abstract; figure 1, 106).

Regarding claim 11, Kanevsky teaches a method for receiving advertisement contents sent from an advertisement provider using an advertisement provider terminal through a communications network, and sending the received advertisement contents to at least one advertisement user from an advertisement server, said method comprising the steps of:

storing the advertisement content sent from the advertisement provider using the advertisement provider terminal and advertisement attribute information in association with each other (abstract; figure 1; col. 1, line 59 to col. 2, line 7);

storing advertisement user information sent form the at least one advertisement user using the sent advertisement contents (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

retrieving advertisement attribute information conforming to the stored advertisement user information, and extracting advertisement contents corresponding to the retrieved advertisement attribute information; sending the extracted advertisement contents to the at least one advertisement user (figure 3, 209; col. 2, lines 44-57);

outputting and specifying one advertisement content included in the stored advertisement contents, when using an advertisement (abstract); and

outputting the advertisement content specified by said outputting step (abstract).

However, Kanevsky fails to explicitly teach receiving predetermined advertisement contents sent from said advertisement server to the at least one advertisement user and advertisement attribute information corresponding to the predetermined advertisement contents, and storing the received advertisement contents and the advertisement attribute information sequentially in received order.

Itakura teaches receiving predetermined advertisement contents sent from said advertisement server to the at least one advertisement user and advertisement attribute information corresponding to the predetermined advertisement contents, and storing the

received advertisement contents and the advertisement attribute information sequentially in received order (col. 5, lines 1-28; figures 7-12).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Itakura with the teaching of Kanevsky in order to keep track the number of times the advertisement has been transmitted to users, storing the received advertisement in sequential order in order to provide quick access to the storage, updating and retaining the advertisement content in order to make sure that each user receives advertisements, therefore maximizing the system's efficiency.

Claim 15 is similar to claim 1, therefore is also rejected under the same rationale.

#### *Allowable Subject Matter*

Claim 4-6 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 4, the cited prior art of record fails to teach the advertisement distribution system according to claim 3, wherein said advertisement selection unit generates, when more than a predetermined number of items of the advertisement provider information are retrieved, a predetermined number of random numbers which corresponds to the number of the retrieved items of advertisement provider information,

and selects a predetermined number of items of advertisement provider information corresponding to the generated random numbers.

Regarding claim 5, the cited prior art of record fails to teach the advertisement distribution system according to claim 2, wherein said advertisement extraction unit includes a changing unit, which changes an item parameter included in the advertisement specification condition when a number of items of advertisement provider information including the advertisement providing condition does not reach a predetermined number, so as to search the advertisement providing condition conforming to the changed item parameter included in the advertisement specification condition.

Claim 6 would be allowed because it depends on objected claim 5.

Regarding claim 12, the cited prior art of record fails to teach the method according to claim 11, further comprising the steps of: determining whether the obtained number of output advertisement contents exceeds a maximum number of to-be-provided advertisement included in the stored advertisement attribute information; and when determined that the obtained number of output advertisement contents has exceeded the maximum number of to-be-provided advertisements, removing the advertisement content from target advertisement contents to be extracted by said extracting step.

Claim 13 would be allowed because it depends on objected claim 12.

Claim 14 would be allowed because it depends on objected claim 12.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US Pub. No. 2004/0039784 by Jacobs et al.
2. USPN 6,539,420 issued to Fields et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is (703) 305-5104. The examiner can normally be reached on Monday-Thursday (9:00 am-7:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ANB*

ANB

*Jack B. Harvey*  
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SUPERVISORY PATENT EXAMINER